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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,729	12/27/2000	Masaaki Yamamoto	9683/74	3943

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EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/720,729	YAMAMOTO ET AL.	
	Examiner	Art Unit	
	Nghi H. Ly	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25,28-30,33-48 and 83-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25,28-30,33-48 and 83-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

2. Applicant's arguments with respect to claims 25, 28-30, 33-48 and 83-85 have been considered but are moot in view of the new ground(s) of rejection.

On page 6 of applicant's remarks, applicant argues that "*Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious.*" "*The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record.*"

In response, however, this new ground of rejection is not being made with a new reference and/or subsidiary references, because the examiner in the previous Office action (dated 07/28/06) has switched the references (not because the references do not teach), the reason that the examiner switched the references because Wells does indeed teaches most of applicant's claimed limitations. Therefore, Wells cited as a main

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reference and Nishino as a secondary reference, for this reason, the examiner maintains the same references (Wells in view of Nishino) that have been cited in the previous Office action (dated 07/28/06) since the examiner believes that the cited references (Wells in view of Nishino) in the previous Office action (dated 07/28/06) indeed teach applicant's claimed invention. Upon further review, the examiner is of the view that the combination of Wells and Nishino do meet the claimed limitations of applicant's invention.

On pages 8-9 of applicant's remarks, applicant argues that Wells fails to teach the "the viewer" and "the registration control".

In response, the examiner maintains that Wells teaches "the viewer" (see column 2, lines 12-25, see "user" and it reads on applicant's "the viewer"), and "registration control" (see column 10, lines 33-39 and column 14, lines 1-43, see "a controller" and it reads on applicant's "the registration control". In addition, applicant's specification fails to further define what "the viewer" and "the registration control" are. Therefore, the teaching of Wells does indeed teach applicant's claimed limitations using the broadest reasonable interpretation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 25, 28-30, 33, 34, 38, 39, 41-48, 84 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al (US 5,870,683) in view of Nishino (US 6,233,452).

Regarding claim 25, Wells teaches a mobile communication terminal that receives communications services from a mobile wireless network (see fig.2, RF connection between a mobile communication terminal 10 and a mobile wireless network 32. In addition, see column 3, lines 2-5, see "Internetworking"), comprising: a communication control that selectively implements multiple communication functionalities comprising a voice communication functionality (column 3, lines 8-14, see "speech"), an electronic message communication functionality (column 10, lines 9-25, see "Short Message Service (SMS) message") and a network functionality (column 10, lines 9-25, see "can be loaded from the network 32"), wherein while implementing the multiple communication functionalities, at least one standby state is realizable in which

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no user action is prompted (Abstract and column 2, lines 13-25, see "Idle state"), a viewer that activates the network functionality to selectively access information provider servers located in the second network (column 10, lines 9-25, see "can be loaded from the network 32" and see column 3, lines 2-5, see "Internetworking" and "*a connection to land line trunks*" and they read on applicant's "*the second network*") and receive one or more blocks of screen data (Abstract and column 2, lines 13-25, see "Idle state" and "selectively display" and "displayed during an Idle state", and see column 3, line 54 to column 4, line 10 and see fig.3A to fig.4C. In addition, see column 4, lines 47-53, see "be erased and replaced with the same or different characters") from the accessed information provider server for preview of the received one or more blocks of screen data by a user of the mobile communication terminal (column 10, lines 9-25, see "can be loaded from the network 32". In addition, applicant's specification fails to disclose or define the newly added "preview"), a registration control upon a selection by the user of one block of screen data through the preview of the received one or more blocks of screen data, stores the selected one block of screen data in one of multiple memory areas each correlatable to any one of the at least one standby state (see column 4, lines 11-16 and see column 8, lines 9-13, and see Abstract and column 2, lines 13-25, see "Idle state" and "selectively display" and "displayed during an Idle state"), a correlation control responsive to an instruction from the user to dynamically correlates the one of the multiple memory areas to a selected one of the at least one standby state selected by the user (see column 2, lines 12-25, see "selectively display" and column 8, lines 9-13, see "user choice", and see column 5, lines 39-45, see "if a user selects an

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animation". Wells teaches "selectively display" and "if a user selects an animation" and they read on Applicant's "dynamically correlates"), and a display control that, when the terminal is in the selected one of the at least one standby state, displays the selected one of the one or more blocks of screen data (Abstract and column 2, lines 13-25, see "Idle state" and "selectively display" and "displayed during an Idle state" and see column 5, lines 39-45, see "if a user selects an animation" or see column 8, lines 14-15, see "selected animation").

Wells does not specifically disclose a network browsing functionality for browsing a second network located outside the mobile wireless network and the viewer that activates the network browsing functionality access information provider servers located in the second network.

Nishino teaches disclose a network browsing functionality for browsing a second network located outside the mobile wireless network and the viewer that activates the network browsing functionality access information provider servers located in the second network (see Abstract and column 13, line 65 to column 14, line 5, see "browsing", "Web page" and "Internet". Nishino's "*Internet*" reads on applicant's "a second network located outside the mobile wireless network").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nishino into the system of Wells so that the terminal is allowed to download an electronic destined therefor (see Nishino, Abstract).

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Regarding claim 28, Wells further teaches the data source is located outside the network and connected to the network over at least one public data communication network (column 10, lines 9-25, see "can be loaded from the network 32").

Regarding claim 29, Wells further teaches the data source is another communication terminal (see column 10, lines 9-25, see "can be loaded through the external data connection 28").

Regarding claim 30, Wells further teaches the data source is a server that provides information (column 4, lines 5-10, see "network provider").

Regarding claim 33, Wells further teaches the registration control determines, based on one or more attributes attached to the selected one of the one or more of the received screen data, whether the selected block of the received screen data is storable (see column 3, line 54 to column 4, line 10, and column 4, lines 11-14).

Regarding claim 34, Wells further teaches one of the attributes is a size of the selected block of the received screen data (see column 3, line 54 to column 4, line 10).

Regarding claim 38, Wells teaches one of the attributes is a communication protocol adopted in the network (see column 10, lines 9-25, the teaching of Wells inherently teaches Applicant's "one of the attributes is a communication protocol adopted in the network").

Regarding claim 39, Wells teaches different screen data is selectively displayed in a standby state (Abstract and column 2, lines 13-25, see "Idle state" and "selectively display" and "displayed during an Idle state" and see column 5, lines 39-45, see "if a user selects an animation" or see column 8, lines 14-15, see "selected animation").

Regarding claim 41, Wells teaches different screen data is displayed in a standby state in a periodic rotation (column 4, lines 1-4, see "displayed sequentially").

Regarding claim 42, Wells further teaches one of the at least one standby state is a standby state in which the terminal is waiting for a call to come in or for the user to key in (see Abstract).

Regarding claim 43, Wells further teaches one of the at least one standby state is a state of downloading data from the data source (see Abstract and column 10, lines 10-25).

Regarding claim 44, Wells further teaches the display control keeps displaying screen data until an occurrence of an event triggers a shift from the standby state (see column 2, lines 12-33).

Regarding claim 45, Wells further teaches the selected one of the one or more of the screen data is processed for display (see column 3, line 54 to column 4, line 10).

Regarding claim 46, Wells further teaches the size of the image represented by the selected one of the one or more of the screen data is adjusted (see column 10, lines 21-24).

Regarding claim 47, Wells further teaches the image represented by the selected one of the one or more of the screen data is repeated (column 4, lines 1-4, see "displayed sequentially").

Regarding claim 48, Wells further teaches the image represented by the selected one of the one or more of the screen data is placed at a designated location on a display of the terminal (see fig.3A and 3B).

Regarding claim 84, Wells and/or Nishino further teaches the second network is an Internet (see Wells, column 3, lines 2-5, see "Internetworking" or see Nishino, Abstract).

Regarding claim 85, Wells and/or Nishino further teaches the one or more blocks of screen data are received from a web page on the Internet (see Wells, column 3, lines 2-5, see "Internetworking" or see Nishino, Abstract).

6. Claims 35, 36, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al (US 5,870,683) in view of Nishino (US 6,233,452) and further in view of Official notice.

Regarding claims 35, 36, 37 and 40, the combination of Wells and Nishino teaches claim 25. The combination of Wells and Nishino does not specifically disclose the attributes is copyright protection *or* one of the attributes is identification of a network through which the screen data was downloaded received one of the attributes is an encryption method with which the screen data is encrypted *or* different screen data is randomly displayed in a standby state. However, the examiner takes Official notice that such feature as recited is very well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination as claimed in order to improve one of the attributes is copyright protection *or* one of the attributes is identification of a network through which the screen data was downloaded received one

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of the attributes is an encryption method with which the screen data is encrypted or different screen data is randomly displayed in a standby state.

7. Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al (US 5,870,683) in view of Nishino (US 6,233,452) and further in view of Thompson et al (US 5,809,433).

Regarding claim 83, the combination of Wells and Nishino teaches claim 25. The combination of Wells and Nishino does not specifically disclose one of the at least one standby state is a state of receiving an e-mail.

Thompson teaches one of the at least one standby state is a state of receiving an e-mail (see column 1, lines 45-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Thompson into the system of Wells and Nishino so that during the standby mode, the radio telephone can receive electronic mail.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

A handwritten signature in black ink, appearing to be 'Nghi H. Ly', written in a cursive style.